

Appln. No. 10/623,642

Attorney Docket No. 10541-1814

IV. Remarks

In response to the Office Action mailed June 30, 2004, kindly enter the foregoing amendment and consider the following remarks. Pursuant to 37 CFR §1.112, Applicant(s) request reconsideration of each and every ground of rejection set forth in the Office Action. The Office Action and the references cited therein have been carefully considered. In this Amendment, claims 21 and 22 have been added. Thus, claims 1-22 are pending and are at issue herein. In view of these amendments and the following remarks, favorable reconsideration of this application is requested.

ALLOWABLE SUBJECT MATTER

The Applicant(s) would like to thank the Examiner for acknowledging patentable subject matter. Specifically, the Examiner noted that claims 5-8, 15, 16, and 19 would be allowable if rewritten in independent form. At this time, the Applicants have not amended these allowable claims into independent form as the independent claims on which they are based, namely claims 1, 13, and 17 are believed to be in condition for allowance.

STATEMENT OF COMMON OWNERSHIP

The present application (serial number 10/623,642) and Patent No. 6,619,272 ("Jones") were, at the time the invention of the present application (serial number 10/623,642) was made, owned by Visteon Global Technologies. See MPEP § 706.02(I)(2).

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CLAIM REJECTIONS UNDER 35 USC §103

Claims 1-4, 9 and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Joos (U.S. Patent No. 6,412,475) in view of Jones (U.S. Patent No. 6,619,272). The Applicant(s) respectfully traverses these rejections.

In furtherance of the above statement of common ownership, the Jones reference is precluded from use as prior art under § 103(a) and (c) because, at the time of invention of the present application, the Jones patent was commonly assigned to Visteon Global Technologies, Inc. as is the present application, and the Jones patent only qualifies under 35 U.S.C. § 102(e). See MPEP § 706.02(l)(1). Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw any § 103(a) rejections based on Jones.

Although the outstanding rejections have been fully traversed by the disqualification of the Jones reference, the Applicants will take the opportunity to briefly discuss the Joos reference. Unlike the present invention, the Joos reference only discloses a single outlet from the filter housing to which the fuel line 13.1 is connected. See Joos at Fig. 1 (shown but not numbered). This results in the jet pump 27 being fed from a return conduit 11 that is attached to the fuel supply line 13.1. See *Id.* at Fig. 1 and col. 4, lines 54-56. In no way is the conduit 11 a part of the filter or its housing. The return conduit 11 is equipped with a blocking valve 10 and throttle 10.1 allowing the jet pumps to be enabled or disabled for different modes of operation. *Id.* at col. 4, lines 43-55.

In contrast, the present invention discloses a filter housing with two outlets; one attached to the fuel supply line and the other attached to supply fuel to the jet pump. In addition, the line feeding the jet pump does not require any type of blocking valve or

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throttle, unlike the Joos reference. This results in the present invention being lighter and having a much simpler and lower cost design than the configuration disclosed in Joos.

For these reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under § 103.

NEW CLAIMS

The Applicant(s) would also like to direct the Examiner's attention to new claims 21 and 22 shown above which further distinguish the present application from the Joos reference. In particular, claim 21 recites the second outlet being independent of the first outlet, and claim 22 recites the first and second outlets being positioned inside the housing. It is respectfully submitted that neither of these features are shown in the prior art of record, and favorable consideration is respectfully requested.

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CONCLUSION

In view of the preceding amendments and remarks, the Applicant(s) respectfully submit that the specification is in order and that all of the claims are now in condition for allowance. If the Examiner believes that personal contact would be advantageous to the disposition of this case, the Applicants respectfully request that the Examiner contact the Attorney of the Applicants at the earliest convenience of the Examiner.

8/13/04

Date

Respectfully submitted,


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